



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,907	12/22/2000	Takahiro Endo	1344.1052 (JDH)	6594

21171 7590 02/04/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

RETNA, YEHDEGA

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,907

Applicant(s)

ENDO ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites "(A) computer readable recording medium recorded with an advertisement information providing program for realizing on a computer, in the preamble. However the body of the claim recites "a card sending service", "an advertisement information adding function" and "an advertisement information presenting function". It is not clear whether applicant is claiming program parts, which are part of the program recited in the preamble or method steps. If these features mentioned above are program parts then the preamble should include a statement indicating that the program parts are part of the advertisement information-providing program.

Claims 16-20 are rejected since they are dependent to rejected claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3622

Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Merely claiming nonfunctional descriptive material stored in computer readable medium does not make the invention eligible for patenting. For example, claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 USC § 101 since the information stored may have some “real world” value. However, the mere fact that the claim may satisfy the utility requirement of 35 USC § 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

The application is claiming a program stored on a computer readable medium for realizing on a computer. The claimed invention does not claim an executable computer program or software, when executed by a computer to perform the claimed steps.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 15 and claims depending from are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Intellipost as taught by the article “Intellipost Launches BonusMail with 50,000 Charter

Art Unit: 3622

Members; First-of-Its Kind Internet Directronic Mail Gives the Reins to Consumers. Hereinafter (BonusMail).

Regarding claims 1-4, BonusMail teaches providing a card sending service for sending card with message attached to a specified recipient; inputting preference trends of recipient, selecting advertisement information suitable for the trends of the addresses and adding the advertisement information to the card... (see page 1 and 2).

Regarding claims 5 and 6, BonusMail teaches counting utilization frequency of the card sending service and changing additional information to be added to the card based on the utilization frequency and inputting the additional information to the card ... BonusMail teaches rewarding members based on utilization frequency of the card service and the reward information being including in the card (see page 2).

Regarding claim 7, BonusMail teaches sending non-visual advertisement information specified by the identification information. BonusMail teaches sending advertisement messages sent in the format appropriate for their e-mail software (see page 2).

Claim 8 is rejected as stated above in claim 1.

Regarding claims 9-11, BonusMail teaches sending card attached with an optional message to a specified addressee, inputting preference trends...; selecting advertisement information suitable for the preference trends and selecting and presenting the selected advertisement information (see page 1 and 2).

Claims 12 and 13 are rejected as stated above in claims 5 and 6.

Claim 14 is rejected as stated above in claim 7.

Claims 15-17 are rejected as stated above in claim 9-11.

Art Unit: 3622

Claims 18 and 19 are rejected as stated above in claim 5 and 6.

Claim 20 is rejected as stated above in claim 7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stanbach U.S. Patent No. 6,449,657 teaches electronic mail with advertisement.

Moraes U.S. Patent No. 6,014,502 teaches electronic mail system with advertisement.

Van Dusen U.S. Patent No. 6,178,823 teaches electronic gift certificate with message attached.

Shaw et al. U.S. Patent No. 6,199,106 teaches electronic mail system with advertisement.

Kidron U.S. Patent No. 6,464,583 teaches electronically placed wagers for another.

Sugimoto et al. JP 11-242714 (translation) teaches sending electronic card with message attached and prize lottery.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Application/Control Number: 09/741,907
Art Unit: 3622

Page 6

A handwritten signature in black ink, appearing to read "Yehdega Retta". The signature is fluid and cursive, with the first name "Yehdega" and the last name "Retta" clearly distinguishable.

Yehdega Retta
Examiner
Art Unit 3622

YR